

REMARKS

Applicants have carefully reviewed the Office Action dated May 28, 2004. Claims 1-5, 25-30, and 71-73 were rejected, claims 6-11, 31-33, and 75-77 were objected to, and claims 12-24, 34-70, and 74 have been withdrawn from consideration. Claims 5, 28 and 71 have been amended in this response.

The Examiner indicated that the Information Disclosure Statement filed 7/22/02 failed to comply with 37 C.F.R. 1.98(a)(2). Applicants assert that the references on this Information Disclosure Statement were properly submitted, and will enclose the return postcard receipt as evidence of this. However, in order to facilitate timely prosecution Applicants have also included an additional set of copies of the required references.

Claims 1-5, 25-30 and 71-73 were rejected under 35 U.S.C. §102(e) as being anticipated by Khosravi, U.S. Patent 6,129,739 (hereinafter Khosravi). Applicants respectfully traverse this rejection. In order for a reference to anticipate a claim, all of the elements of the claim must be present in the reference. See M.P.E.P. §2131. Claim 1 recites, "wherein the guide wire is deliverable within a vessel independently of the embolic filter." The disclosure of Khosravi does not disclose such a device. As column 10, lines 27-29 state, "sheath 143 may rotate with respect to guide wire 132 but is translationally restrained by stops 145 and 146." Because the sheath 143 is translationally restrained, the device in Khosravi does not disclose a guide wire and filter that can be delivered independently of one another. There is no statement or drawing of the device in Khosravi that shows a guide wire and a filter that can be deployed separately. Applicants assert that all of the elements of claim 1 are not disclosed in Khosravi, and claim 1 is not therefore anticipated. Because they are

dependent on claim 1 and because they contain additional patentably distinct elements, Applicants assert that claims 2-5 and 25-27 are also not anticipated.

Claim 28 recites a sheath that is “translatable from a proximal end of the guide wire to a point when the open proximal end of the sheath is distal of the stop mechanism.” Nothing in Khosravi discloses that the sheath/filter assembly (for example, in Figure 8 or 11A) is translatable from the proximal end of the guide wire to a point when the open proximal end of the sheath is distal of the stop mechanism. It appears that the sheath is maintained between, for example, stops 145 and 146 (again, see column 10, lines 27-29 of the text for further description). Because they are dependent on claim 28 and because they contain additional patentably distinct elements, Applicants assert that claims 29-30 are also not anticipated.

Claim 71 was amended in order to correct a clerical error. Claim 71 recites “a one-way translation member affixed to the guide wire.” Khosravi does not contain any reference to a one-way translation member. The stops 145 and 146 in Khosravi do not allow translation over them in either direction, much less in one direction only. Because they are dependent on claim 71 and because they contain additional patentably distinct elements, Applicants assert that claims 72-73 are also not anticipated.


Claim 78 was amended to correct a clerical error. An extra period was deleted from the end of the sentence. The Examiner did not reject or object to claims 78-80. Applicants respectfully assert that these claims are allowable. Claim 78 recites a sleeve member that has a “means for releasably locking the translational position of a device.” Such an element is not present in the Khosravi disclosure, and claim 78 is allowable. Because they are dependent on allowable claim 78 and because they contain additional patentably distinct elements, claims 79-80 are also allowable.

Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,
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By their Attorney,

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